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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		10/712,879	November 13, 2003
		First Named Inventor	
Mohamed Khalil		Art Unit	Examiner
2619		Blanche Wong	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 36,366 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

D. Scott Hemingway
Signature

D. Scott Hemingway

Typed or printed name

214-292-8301

Telephone number

9/26/08
Date

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P1029(15710RRUS02)



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Khalil et al

Serial No.: 10/712,879

Filed: November 13, 2003

For: Mobile IP Over VPN Communication Protocol

Group Art Unit: 2619

Examiner: Wong, Blanche

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW OF
FINAL OFFICE REJECTION MAILED JUNE 26, 2008**

In response to the Office Action mailed June 26, 2008, the Applicants respectfully request reconsideration and reversal of the Final Rejection in light of the following arguments.

INTRODUCTORY COMMENTS

Claims 1-20 were rejected under §112, ¶1 as non-enabling for various reasons relating to independent claims 1, 8 and 16, and Claims 1-15 were rejected under §112, ¶2 as indefinite for various reasons articulated for claims 1, 8, and 16. Both types of rejections are addressed below.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date:

September 26, 2008

Amy Kasper

Amy Kasper

REMARKS

The Examiner makes three fundamental errors in the Final Rejection. First, the Examiner relies on her technical review of only one embodiment of the invention, and ignores the other embodiments that support the claimed invention. After the other embodiments are considered, these rejections should be withdrawn. Second, the Examiner relies on a misconstruction of the claim to support a perceived non-enabling rejection. After the claim is properly construed, this rejection should also be withdrawn. Third, while the Examiner acknowledges that the specification supports part of the claimed subject matter, the Examiner requires that the claims include a whole assortment of other components and limitations identified in the Detailed Description in order to correctly "reflect the invention." There is no need to include every detail from the specification in each claim. The Examiner also indicated that Claim 8 was previously allowed, but the Applicant's review of the file history indicates that the Examiner has never allowed any claims in this case at any time.

I. THE EXAMINER'S IMPROPER FOCUS ON ONLY ONE TECHNICAL EMBODIMENT TO THE EXCLUSION OF ALL OTHER EMBODIMENTS

The Examiner's Office Action rejects Claim 1, 8 and 16 under 35 U.S.C. §112 after focusing exclusively on one technical embodiment discussed on pages 21-24 of the Specification. The Examiner contends that the claims are not allowable because each claim limitation in every claim is not supported by this single embodiment from page 21-24 of the Specification. The Examiner, however, ignores the numerous other embodiments in the application, which is deemed inappropriate.

For instance, the Examiner indicates that the single embodiment of the specification relied upon by the Examiner does not support the claim 1 requirement that the security gateway transmits packets to the mobile node. *See page 5 of Office Action : (specification does not disclose the VPN-GW transmitting the information packet to the mobile node).* The Applicant refers the Examiner to the other embodiments disclosed in the Specification for support of this limitation, with particular emphasis on Reference Nos. 720, 1120 and 1320 discussed on pages 30, 43-44 and 50. On page 30, the

Specification clearly indicates that “information packet 720 is then transmitted from the VPN-GW 660 to the MN 650 on the foreign network 605.” Contrary to the Examiner’s analysis, this claim is enabled and supported by the written description.

On page 5-6 of the Final Office Action, the Examiner also rejects Claim 16 under 35 U.S.C. §112, because the “specification does not disclose forwarding the information packet without using an external home agent.” As set forth above, the Examiner is incorrect. Direct transmission from the security gateway to the mobile node is supported by the disclosures for Reference Nos. 720, 1120 and 1320, and the Examiner’s attempts to narrowly characterize the Applicant’s disclosure are mistaken.

Claim 16 is also rejected by the Examiner because the cited portions of the Specification focused upon by the Examiner do not support the use of the “inner tunnel address” as a reference to the security gateway. The Examiner is also referred to other portions of the specification, including page 25, lines 5-6 for enabling support of the claims. (“The VPN-TIA 554 is the address for the VPN tunnel inner address for the VPN 460 used in the VPN 475”). Other parts of the specification also support and enable the claimed subject matter. The Examiner’s focus upon a single embodiment is improper and misplaced, and ultimately, that misplaced analysis has led to some problematic rejections of the claims that need to be reversed by this Review Panel.

II. THE EXAMINER’S MISCONSTRUCTION OF THE CLAIMS – “FOR” RELATES TO THE GATEWAY, NOT THE ADDRESS

On page 4 of the Final Office Action, the Examiner indicates that the “inner tunnel address” does not route packets within the virtual private network as claimed in Claim 1. The Examiner rejects Claim 1 under that interpretation of the claim. The Examiner’s construction of Claim 1, however, is incorrect.

The phrase “for routing packets within the virtual private network” modifies and refers back to the “security gateway,” not the “inner tunnel address.” An address does not route packets, but the security gateway does. As properly construed, the claimed phrase of “said security gateway having an inner tunnel address for routing packets within the virtual private network” means that the system has a security gateway with an

assigned inner tunnel address, and that security gateway is placed on the system for routing packets with the virtual private network.

The Examiner indicates that the method in Claim 16 is also incorrect because of the same interpretation of “for routing information packets.” The above discussion can be applied to the Examiner’s rejection of Claim 16 as well. No amendment is necessary to clarify this claim because Claims 1 and 16 are allowable under a reasonable and proper interpretation of the claims.

III. THE EXAMINER’S IMPROPER REQUIREMENT THAT ALL SPECIFIC DETAILS OF THE SPECIFICATION BE PLACED IN THE CLAIMS

On page 4 of the Final Office Action, the Examiner rejects Claim 8 under 35 U.S.C. §112 because Claim 8 indicates that two addresses (the virtual private network tunnel inner address and the virtual private network gateway address) are “sufficient for tunneling the information packet to and within said virtual private network.” The Examiner appears to concede that these two addresses are sufficient to tunnel information packets to the virtual private network and within the virtual private network as claimed.

But, the Examiner indicates that “the invention” is a transmission from a correspondent node to the mobile node (which is not always the case), and other intermediate addresses also discussed in the Specification (CNIP, HAIP, HOA, CCOA) must be claimed as well. The Examiner is wrong on several points. First, Claim 8 does not require a communication from a correspondent node to a mobile node. In fact, correspondent node is not even addressed in Claim 8. Second, all the intermediate steps and components in a communication chain need not be claimed in order to achieve an enabled and supported claim. In this claim, two addresses are sufficient to tunnel the information packet to and within the virtual private network – and those two addresses are claimed.

Nothing else is required to perform the claimed invention, and the claimed invention as set forth in Claim 8 is fully enabled and supported without incorporating every possible intermediate step and component. Lastly, the Examiner focuses on a single embodiment to identify other components or steps in the communication chain, but as discussed above, other embodiments do not make the same requirements upon the

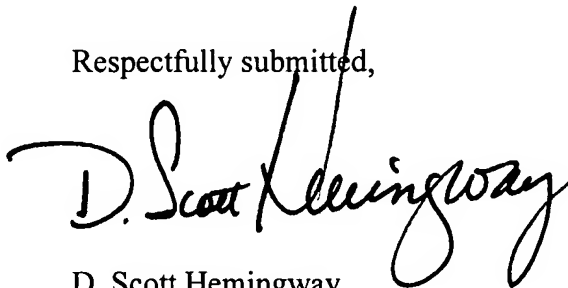
system as the embodiment focused upon by the Examiner. As such, the Examiner's requirement that all possible intermediate steps and components be identified in the claims is not practical, as well as not required under the law.

IV. CONCLUSION

Contrary to the Examiner's Final Rejection, the claims 1-20 are not invalid under 35 U.S.C. §112. The Applicants believe that the present arguments traverse the Examiner's obviousness rejections, and the independent claims are allowable.

It is believed that no additional fees are necessary for this filing. If additional fees are required for filing this response, then the appropriate fees should be deducted from D. Scott Hemingway's Deposit Account No. 501,270.

Respectfully submitted,

A handwritten signature in black ink that reads "D. Scott Hemingway". The signature is written in a cursive, flowing style with a large initial "D" and a long, sweeping underline.

D. Scott Hemingway
Reg. No. 36,366
Attorney for Applicant

Hemingway & Hansen, LLP
Comerica Bank Building, Suite 2500
1717 Main Street
Dallas, Texas 75201
(214)292-8301 (voice)
(214)739-5209 (fax)